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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,552	08/28/2003	Carl F. Oresick	D/A2328	7596

25453 7590 11/27/2006

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EXAMINER

HUYNH, CONG LAC T

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/650,552

Applicant(s)

ORESICK ET AL.

Examiner

Cong-Lac Huynh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 58-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 58-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: amendment filed 9/12/06 to the application filed on 8/28/03.
2. Claims 1-57 are canceled.
3. Claims 64-68 are added.
4. Claims 58-68 are pending in the case. Claim 59 is the independent claim.
5. The rejections of claims 58-63 under 35 U.S.C. 102(a) as being anticipated by Ramaley have been withdrawn in view of the amendment.
6. The rejections of claims 58-63 under 35 U.S.C. 103(a) as being unpatentable over Anglin, Jr. et al. (US 5,892,591, filed 11/22/96) in view of Hadfield et al. (US 2004/0205653, filed 12/17/01) have been withdrawn in view of the amendment.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 58-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anglin, Jr. et al. (US 5,892,591, filed 11/22/96) in view of Braun et al. (US Pat App Pub No 2004/0061888, 4/1/04, filed 9/20/02).

Regarding independent claim 59, Anglin discloses:

- receiving the document from an originator, the document comprising a cover paper sheet, the cover sheet including a cover sheet information, the cover sheet information comprising a document distribution job information (figure 3: receiving document 3200 from the originating facsimile, which is equivalent to an originator, document 3200 comprising cover sheet 3210; col 4, line 39 to col 5, line 9), and the document further comprising one or more document paper sheets, the one or more document paper sheets including a document information, wherein the cover paper sheet is separate and distinct from the one or more document paper sheets (figure 3: document 3200 further comprising message 3220, which is one or more document paper sheets, wherein the cover sheet 3210 is separate and distinct from the document paper sheet)
- scanning the document cover paper sheet to provide the document distribution job information (col 4, lines 48-67, figure 4)

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- distributing the document based on the document distribution job information to one or more recipients (col 5, lines 1-31: transmitting the document via the network computer over the Internet to one or more recipients based on the information on the cover sheet)
- subsequent to receiving the document, returning the document to the document distributing apparatus from at least one recipient (col 5, lines 31-40)

Anglin does not disclose that the document that is received as being returned from the at least one recipient includes cover sheet information that has been modified by the at least one recipient.

Braun discloses updating the facsimile cover sheet of a document of a number of pages by a user ([0007], figure 4).

It would have been obvious to an ordinary skill in the art at the time of the invention was made to combined Braun into Anglin for easily editing the cover sheet of a document to indicate the change of information in the document.

Regarding claim 58, which is dependent on claim 59, Anglin discloses the document is received from the originator by means of the communication network (Anglin: figures 2 and 3).

Regarding claim 60, which is dependent on claim 64, Anglin discloses determining when the current document distribution job is complete, such determining when the current document distribution job is complete including determining when when the

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document has been received from all recipients of the one or more recipients (col 5, lines 18-36).

Regarding claim 61, which is dependent on claim 60, Anglin discloses returning the document to the originator by the document distributing apparatus when it is determined the document distribution job is complete (col 5, lines 22-39).

Regarding claim 62, which is dependent on claim 60, Anglin discloses that it is determined that the current document job is not complete, continue to distribute the document (col 5, lines 22-30, col 6, lines 40-54).

Regarding claim 63, which is dependent on claim 62, Anglin discloses continuing to distribute the document to the remaining recipient or recipients of the one or more recipients (col 5, lines 22-30, col 6, lines 40-54).

10. Claim 64 is rejected under 35 U.S.C. 103(a) as being unpatentable over Anglin and Braun as applied in claim 59 above, and further in view of Hadfield et al. (US 2004/0205653, filed 12/17/01).

Regarding claim 64, which is dependent on claim 59, Anglin and Braun do not disclose that the document that is received as being returned from the at least one recipient

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includes document sheet information that has been modified by the at least one recipient.

Hadfield discloses sending a document to the collaborators or contributing authors for reviewing, these contributing authors, when receiving the document, will propose changes and add comment to the document and return the modified document to the sender ([0009]-[0010], [0013]-[0015]).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Hadfield into Anglin and Braun since modifying the received document and returning the modified document to the sender in Hadfield would provide the advantage to incorporate into distributing a document to a recipient in Anglin and Braun for allowing the recipient to modify the received document with comments or changes and send back such a document to the distributor.

11. Claims 65-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anglin, Jr. et al. (US 5,892,591, filed 11/22/96) in view of Braun et al. (US Pat App Pub No 2004/0061888, 4/1/04, filed 9/20/02).

Regarding claim 65, which is dependent on claim 59, Anglin discloses determining when the current document distribution job is complete, such determining when the current document distribution job is complete including determining when the document has been received from all recipients of the one or more recipients (col 5, lines 18-36).

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Regarding claim 66, which is dependent on claim 65, Anglin discloses returning the document to the originator when it is determined that the document distribution job is complete (col 5, lines 22-39).

Regarding claim 67, which is dependent on claim 65, Anglin discloses that it is determined that the current document job is not complete, continue to distribute the document (col 5, lines 22-30, col 6, lines 40-54).

Regarding claim 68, which is dependent on claim 67, Anglin discloses continuing to distribute the document to the remaining recipient or recipients of the one or more recipients (col 5, lines 22-30, col 6, lines 40-54).

Response to Arguments

12. Applicant's arguments filed 9/12/06 have been fully considered but they are not persuasive.

Applicants argue that Ramaley does not disclose claim 59 as amended. However, Anglin and Braun disclose the amended feature. See office action.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Euchner et al. (US 2005/0138541). Scherk et al. (US 5,068,888).

Kuruoglu et al. (US 2002/00780088). Bagley et al. (US 5,548,700).

Mahoney et al. (US 5,659,639). Cass et al. (US 5,692,073).

Bagley et al. (US 5,734,761). Ouchi et al. (US 5,991,371).

Quach (US 2003/0169854). Harris (US 2003/0226885).

Sanjay-Gopal et al. (US 2006/0036471).

Irons et al. (US 2006/0082822). Warren et al. (US 2006/0140469).

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Thurs (9:00-7:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cong-Lac Huynh
Primary Examiner
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11/16/06